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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,921	04/12/2001	Kazunori Masaki	35.G2772	5234
5514	7590	12/22/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/832,921	Applicant(s) MASAKI, KAZUNORI	
	Examiner Andrew J. Fischer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,43-51,67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,43-51,67 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on September 15, 2005. This application was under a final rejection (the Second Final Office Action mailed March 18, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the Second Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114. This is the second RCE in this application.

Acknowledgements

2. In accordance with the RCE noted above, Applicant's amendment filed September 1, 2005 is acknowledged. Accordingly, claims 1-9, 43-51, 67, and 68 remain pending.
3. This Office Action, the "Forth Non Final Office Action" is given Paper No. 20051220. All paper numbers and office action titles provided are for reference purposes only.
4. All references in this Office Action to the capitalized versions of "Applicant" refers specifically the Applicant of record. References to lower case versions of "applicant" or "applicants" refers to any or all patent "applicants." Unless expressly noted otherwise, references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
5. This application in an image file wrapper ("IFW") application. Applicant's response is therefore separated before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the

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Examiner highly recommends Applicant place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.

6. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181. The specification is replete with these errors. Some examples follow:

- i. The “means for detecting a first print setting information” as recited in claim 4.
- ii. The “means for selecting an output server in accordance with the second print setting information” as recited in claim 4.
- iii. The “means for detecting a first print setting information” as recited in claim 43.

Claim Rejections - 35 USC §112 2nd Paragraph

8. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 4-6, 43, 44 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

- a. In claims 4 and 43, Applicant has not clearly linked and associated the “means for” phrases to any corresponding structure.

Claim Rejections - 35 USC §102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-9, 43-51, 67, and 68, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Adamske et. al. (U.S. 6,615,234 B1)(“Adamske”).

Discloses detecting a first print setting (which particular drawer the paper will be drawn from); a second print setting (print 2 sides or 1 side); a third print setting (size of the paper to be printed on); a forth print setting (whether or not to use staples); a fifth print setting (increasing or decreasing the contrast) displaying these print settings to a user; selecting an output server (the server in which the user is connected to).

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12. Claims 1-9, 43-51, 67 and 68, as understood by the Examiner, are also rejected under 35 U.S.C. §102(b) as being anticipated by Huberman (U.S. 5,826,244). Huberman discloses detecting a request for services (for printer services); detecting an upper limit to be paid for the services (the upper limit with the user's price range); displaying a user interface (a webpage) to enable a user to select one of the designated pay service (the lowest bidder) or a pay service other than the designated pay service (the non lowest bidder or ever some completely new service within the user's price range).

Claim Rejections - 35 USC §103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-9, 43-51, 67, and 68, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske.¹ It is the Examiner's principle position that the claims are anticipated because Adamske discloses credit accounts and the associated features of credit accounts are inherent.

However if not inherent, Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Adamske to substitute

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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services for products. It is the Examiner's position that paying for either a products or services have become art recognized equivalents. See MPEP §2144.06.

15. Claims 1-9, 43-51, 67, and 68, as understood by the Examiner, are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Huberman.² Again, it is the Examiner's principle position that the claims are anticipated. However if not anticipated, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Huberman to include any missing features. These modifications would be considered insubstantial and will not patentably distinguish the claimed invention over the prior art.

16. As previously noted, the Examiner confirms that the Official Notice statements in the previous office actions are taken to be admitted prior art. See MPEP §2144.03.

17. The Examiner again confirms that Applicant has elected not to recite any product-by-process claims. See the Second Non Final Office Action, Paragraph No. 25.

18. For due process purposes and because Applicant has not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicant has decided not to be his own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.³ First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second,

² Id.

³ See the Third Non Final Office Action mailed September 9, 2004, Paper No. 090704, Paragraph No. 23 beginning on page 7,; the Second Final Office Action mailed March 18, 2005, Paper No. 03122005, Paragraph No. 22 beginning on page 7.

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the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements⁴ with the required clarity, deliberateness, and precision.⁵

Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁶ Applicant's three (3) responses have not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant did not argue lexicography *was* invoked). Forth and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁷ to be his own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicant's latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R.

§1.111(b). Moreover, Applicant's latest response—while fully considered by the Examiner—

⁴ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁵ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁶ See Note 3.

⁷ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was

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has not changed the Examiner's reasonable conclusion that Applicant has decided not to be his own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is again confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁸

Response to Arguments

19. Applicant's arguments filed September 15, 2005 have been fully considered but they are not persuasive.

20. Regarding the objections to the specification, Applicant's argument argues that "the Office Action's position is wholly misplaced."⁹ The Examiner disagrees. See again the authorities noted within the section titled "Specification" of this and previous office actions with particular emphasis on MPEP §2181.

21. Regarding an upper limit of an amount designated by a user to be paid for the print first print service is inherent since when the system tries charging the user \$1,000,000 for a few

interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

⁹ Applicant's Remarks" filed September 15, 2005, Page 9, ¶3.

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copies, the user either says "No" or communicates a "No" by walking away or withdrawing his or her offer to purchase.

22. Regarding Huberman, Applicant's arguments have been considered but are not persuasive.

Conclusion

23. References considered pertinent to Applicant's disclosure are listed on form PTO-892.

All references listed on form PTO-892 are cited in their entirety.

24. Unless expressly noted otherwise by the Examiner or other appropriate USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by or from the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005. MPEP citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004 while MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicant is hereby given actual notice that if after reasonably reading any reference of record, if Applicant can not reasonably understand or if Applicant has difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicant should (in his next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicant’s response must also state *why* he either does not understand or has difficulty comprehending the reference. If after properly receiving (*i.e.* Applicant’s response is made of record) both Applicant’s request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the

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Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks" (beginning on page 9) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁰ the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.

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 12/20/05

Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 20, 2005

¹⁰ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.